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In re Application of :
Kaslow, David C., et al. :
Application No.: 09/554,960 :
PCT No.: PCT/US98/25742 : DECISION ON
Int. Filing Date: 04 December 1998 : PETITION
Priority Date: 05 December 1997 : UNDER 37 CFR 1.181
Attorney Docket No.: 15280-3421PC : AND 37 CFR 1.137(a)
For: VACCINES FOR BLOCKING TRANSMISSION :
OF PLASMODIUM VIVAX :

This decision is in response to "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unavoidably Under 37 CFR 1.137(a)," which has also been treated as a petition under 37 CFR 1.181 for the reasons set forth below. As authorized in the communication, the required 1.137(a) petition fee has been charged to deposit account 20-1430.

BACKGROUND

On 04 December 1998, applicants filed international application PCT/US98/25742. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 June 1999.

On 01 July 1999, applicants filed a Demand for international preliminary examination, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty month period for paying the basic national fee in the United States expired on 05 June 2000.

On 22 May 2000, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 23 June 2000, USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The Notification of Missing Requirements set a one month extendable time period for reply.

On 01 June 2001, USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the above-identified application was abandoned for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 23 June 2000.

On 09 October 2001, applicants filed the instant "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unavoidably Under 37 CFR 1.137(a)," which was accompanied by, *inter alia*, a declaration of Michele Simone, and a printout of an excerpt of the docket for 08/01/00 to 08/31/00.

DISCUSSION

Nonreceipt of the Notification of Missing Requirements

If applicants can establish nonreceipt of the NOTIFICATION OF MISSING REQUIREMENTS, then the application was never abandoned. In such case, the holding of abandonment will be withdrawn pursuant to 37 CFR 1.181. See MPEP § 711.03(c), para. I. Accordingly, the instant petition has been treated as a petition under 37 CFR 1.181 rather than under 37 CFR 1.137(a).

The showing required to establish nonreceipt of an Office communication is set forth in the notice entitled *Withdrawing the Holding of Abandonment When Office Actions Are Not Received*, 1156 O.G. 53 (Nov. 16, 1993). The showing must include: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket record must also be referenced in practitioner's statement).

Item (1) has been met. As to (1), practitioner's statement that "Accordingly, as far as we are aware, such a Notice of Missing Requirements was never received by us," satisfies this requirement.

Item (2) has been met. As to (2), practitioner states, "After receipt of the Notice of Abandonment, we diligently examined our corresponding file and docket records to determine if the Notice of Missing Requirements had been received by us. Such a notice was not found in the corresponding file, and our docket records do not reflect receipt of such a notice."

Item (3) has not been met. (3) Docket clerk Michele Simone states that "attached is an excerpt of the relevant part of the Docket identifying entries having a due date of August 23, 2000." However, the Notification of Missing Requirements set a one month period for reply. As such, the relevant date is July 23, 2000.

Petition to Revive Unavoidably Abandoned International Application for Patent

A petition to revive an application for patent unavoidably abandoned under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, (2) the petition fee, (3) a satisfactory showing that the entire delay in filing the required reply from the due date for the reply until the

filing of a grantable petition to 1.137(a) was unavoidable and (4) a terminal disclaimer if application was filed before June 8, 1995.

Items (2) and (4) have been met. (2) The petition fee will be charged to deposit account no. 20-1430, as authorized by the petition. (4) A terminal disclaimer is not required as the application was filed after June 8, 1995.

Item (1) has not been met. The required reply is an executed oath or declaration. Neither has not been filed. Further, a Continued Prosecution Application is improper as the requirements of 35 U.S.C. §371 have not been met. See 37 CFR 1.53(d)(1)(C).

Item (3) has not been met. As applicant has not established that the Notification of Missing Requirements was not received, it is assumed that it was received. As such, the delay was not unavoidable.

CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

The petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181 and 1.137(a)." No additional petition fee is required.

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.


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